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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/945,273	08/30/2001	Shinako Matsuyama	09792909-5135	3839

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EXAMINER

SIMITOSKI, MICHAEL J

ART UNIT	PAPER NUMBER
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2134

DATE MAILED: 11/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/945,273

Applicant(s)

MATSUYAMA ET AL.

Examiner

Michael J. Simitoski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The response of 9/8/2005 was received and considered.
2. Claims 1-29 are pending.

Response to Arguments

3. Applicant's arguments with respect to claims 1-29 have been considered but are moot in view of the new ground(s) of rejection. Ginter discloses a content distribution system where content is distributed with rules for accessing the content, such as confirming the identity of a user. While user names, groups, identities, etc. are well-known in the art to be associated with certificates, Moreh is cited for teaching explicitly verifying a certificate of a user to allow the user to access messages. Therefore, it would have been obvious to modify Ginter to use the user names in the rules for accessing to authenticate a user based on the user's identified certificate.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4, 8-10, 12, 15, 22-23, 26 & 28-29, are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,892,900 to Ginter et al. (**Ginter**) in view of U.S. Patent 6,158,007 to Moreh et al. (**Moreh**).

Regarding claims 1-2, 8-10, 12, 15-16, 24, 26 & 28-29, Ginter discloses an identification certificate issued by an identification authority/trustworthy entity (col. 210, lines 31-45) containing a template serving as identification data of a user receiving a content, said template including at least one piece of personal biotic information or personal non-biotic information/name (col. 210, lines 31-45), container information/container in which a content transaction condition/use rights (col. 55, lines 1-11) is set including an identification certificate identifier list/specified employee (col. 55, lines 21-23) associated with said identification certificate (col. 212, lines 1-16), a content key for enciphering a content (col. 223, lines 5-11), a secure container (col. 59, lines 8-15 & col. 134, lines 29-58) including the content enciphered with the content key and said container information (col. 59, lines 8-47), a content distributor for distributing the content by moving said secure container (Fig. 2, #102 & 106), at least one user device/SPU for transacting the content with said content distributor (col. 60, lines 7-16), whereby user authentication is performed (col. 212, lines 1-16). Ginter is silent regarding authentication being performed in accordance with the identification certificate identified on the basis of the identification certificate identifier list when said secure container is moved, so that the content usable on said user device is distributed with content transaction managed. However, Moreh discloses messages accompanied with a list/access control list (Fig. 6, #84 & col. 9, lines 31-60), where authentication is performed based on certificates identified in the list (col. 7, lines 39-47 & col. 9, lines 58-60) to provide security for messages between users on a computer network (col. 4, line 66 – col. 5, line 7). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ginter to explicitly authenticate the user identified in the rights condition using the user's certificate. One of ordinary skill in the art

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would have been motivated to perform such a modification to provide additional security for the secure containers transferred between users on a computer network, as taught by Moreh (Fig. 6, #84, col. 4, line 66 – col. 5, line 7, col. 7, lines 39-47 & col. 9, lines 31-60, col. 7, lines 39-47).

Regarding claims 3 & 17, Ginter discloses the container information including data in which the condition of secondary distribution is set (col. 59, lines 42-48).

Regarding claims 4 & 18, Ginter discloses that said content distributor is a service provider distributing said secure container (Fig. 2, col. 7, lines 45-57 & col. 56, lines 47-55), the service provider authenticating a user of said user device receiving said secure container, subsequently allowing the content to be used on said user device, provided that the user has been authenticated (col. 12, lines 31-38, col. 21, lines 46-59 & col. 212, lines 3-16).

Regarding claims 22 & 23, Ginter, as modified above by Moreh, is silent as to from where the authentication service acquires the user's certificate. However, the examiner takes Official Notice that acquiring a certificate from a certificate authority and subsequently storing the certificate locally is old and well established in the art of authentication as a method of using digital certificates for authentication, while minimizing re-requesting the certificate. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to both contact a certificate authority to acquire the certificate and then to retrieve a pre-stored certificate subsequently. One of ordinary skill in the art would have been motivated to perform such a modification to authenticate the user while minimizing re-requesting of the certificate. This advantage is well known to those skilled in the art.

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6. Claims 5-7, 19-21 & 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Ginter & Moreh**, as applied to claims 1, 15 & 26 above, in further view of U.S. Patent 6,636,966 to Lee et al. (**Lee**). Ginter lacks authenticating the user and informing the service provider of the user authentication, whereby the service provider distributes the content key to the user. However, Lee teaches a host authenticating a user (using the authorization server) and producing an authentication message stating as such to a key server (col. 5, lines 36-38), and the host device delivering the authentication message to a content key server, which returns the content key to decrypt content (col. 5, lines 27-40 & Figs. 2A-2B). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ginter to inform a content key server of an authentication result and request the server return the content key. One of ordinary skill in the art would have been motivated to perform such a modification to enable portions of data on a storage medium and to provide robust security, as taught by Lee (col. 3, lines 26-39, col. 5, lines 27-40 & Figs. 2A-2B).

7. Claims 11 & 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Ginter & Moreh**, as applied to claims 1 & 15 above, in further view of “IBM Cryptolopes, SuperDistribution and Digital Rights Management” by **Kaplan**. Ginter lacks explicitly storing a signature. However, Kaplan discloses that including a signature in a cryptographic container allows the user to authenticate its contents (p. 5, ¶2-3). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ginter to include a signature in the container. One of ordinary skill in the art would have been motivated to perform such a modification to authenticate its contents, as taught by Kaplan (p. 5, ¶2-3).

8. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Ginter & Moreh**, as applied to claim 1 above, in further view of U.S. Patent 5,949,877 to Traw et al. (**Traw**). Ginter, as modified above, lacks user devices authenticating one another when data are transmitted between them, and a data-transmitting user device generating a digital signature to data to be transmitted and a data-receiving user device verifying the digital signature. However, Traw teaches that to protect content from copying or misuse (col. 1, lines 40-48), each device authenticates the other devices (col. 6, lines 63-65) by generating a digital signature which is to be verified by the receiving device (col. 7, lines 5-35). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ginter to include user devices authenticating one another when data are transmitted between them, and a data-transmitting user device generating a digital signature to data to be transmitted and a data-receiving user device verifying the digital signature. One of ordinary skill in the art would have been motivated to perform such a modification to protect content from copying or misuse, as taught by Traw (col. 1, lines 40-48, col. 6, lines 63-65 & col. 7, lines 5-35).

9. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Ginter & Moreh**, as applied to claim 1 above, in further view of U.S. Patent 5,534,855 to Shockley et al. (**Shockley**). Ginter, as best understood, lacks the template/certificate including at least one piece of information selected from among personal biotic information including fingerprint information, retina pattern information, iris pattern information, voice print information, and handwriting information and a non-biotic information including a seal, a passport, a drivers

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license, and a identification card or any combination of the biotic and non-biotic information and a password. However, Shockley teaches that to guard against probing and user penetration, computer systems authenticate the identity of a user with biometrics (col. 1, lines 40-48), which are integrity locked into a certificate along with, for example, the user's public key (col. 5, lines 48-58). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ginter to include biotic data into the certificate (from Moreh). One of ordinary skill in the art would have been motivated to perform such a modification to guard against probing and user penetration by authenticating the identity of a user with biometrics, as taught by Shockley (col. 1, lines 40-48 & col. 5, lines 48-58).

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Simitoski whose telephone number is (571) 272-3841.

The examiner can normally be reached on Monday - Thursday, 6:45 a.m. - 4:15 p.m.. The examiner can also be reached on alternate Fridays from 6:45 a.m. - 3:15 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached at (571) 272-3838.

Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Or faxed to:

(571) 273-8300
(for formal communications intended for entry)

Or:

(571) 273-3841 (Examiner's fax, for informal or draft communications, please label "PROPOSED" or "DRAFT")


Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



MJS

November 21, 2005



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